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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,363	09/26/2003	John William Miller	06459 USA	3026

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AIR PRODUCTS AND CHEMICALS, INC.
PATENT DEPARTMENT
7201 HAMILTON BOULEVARD
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EXAMINER

COONEY, JOHN M

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN WILLIAM MILLER

Application 10/672,363
Technology Center 1700

Mailed: January 12, 2009

Before PAMELA S. BENNETT, *Review Team Paralegal*.

BENNETT, *Review Team Paralegal*.

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received electronically at the Board of Patent Appeals and Interferences on May 12, 2008. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner to address the following matter requiring attention prior to docketing.

APPEAL BRIEF, CLAIMS APPENDIX

A review of the Appeal Brief filed January 12, 2007 reveals that claim 24 in the Claims appendix of the Appeal Brief is not consistent as amended. Specifically, the amendment filed December 27, 2004, cancelled the majority of paragraph 2 (“R is selected from the group consisting of a C1-C10 aliphatic group . . .”) as well as paragraphs 3-5 of claim 24, yet the cancelled wording of paragraph 2¹ reappeared (without a formal amendment) in all the successive amendments and the Appendix to the Appeal Brief. It should be noted that additional minor amendments to this claim were filed on July 5, 2005 and April 18, 2006. 37 CFR § 41.37(c)(viii) (2006) requires “an appendix containing a copy of the claims involved in the appeal.” Correction is required.

CONCLUSION

Accordingly, it is

ORDERED that the application is returned to the examiner:

1. for notification to appellant to file a paper which contains a corrected Claims appendix to replace the existing defective Claims appendix, or for the examiner to issue a PTOL-90 correcting claim 24;
2. for consideration of said paper, if applicable; and
3. for such further action as may be appropriate.

¹ “, a C1-C10 aliphatic group comprising a nitrogen atom or oxygen atom, a C5-C10 cycloaliphatic group comprising a nitrogen atom or oxygen atom, and a C7-C10 araliphatic group comprising a nitrogen atom or oxygen atom;”

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

PSB

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